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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/645,796 | 08/22/2003 | Akinori Shibuya | Q76396 | 8209 |

23373 7590 10/20/2006

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WASHINGTON, DC 20037

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| EXAMINER |
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SCHILLING, RICHARD L

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| ART UNIT | PAPER NUMBER |
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1752

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/645,796

Applicant(s)

SHIBUYA ET AL.

Examiner

Richard L. Schilling

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 12-17, 19 and 21-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4, 12-17, 19, 21, 22 is/are rejected.
- 7) ☒ Claim(s) 3 and 23-28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10-06-06 has been entered.

2. Claims 1, 2, 4, 12-17, 19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoi et al. in view of Fujimaka et al. and Aoshima et al. for the same reasons as set forth in paragraph 1 of the final rejection filed 6-6-06. The acid generators in Aoi et al (col.42, line 61-col.43, line 3) are chosen from known compounds that are light sensitive acid or radical generators even though electron beams or X-rays are used in the processes of Aoi et al. Also, Fujimaka et al. and Aoshima et al (col.4, line 55-col. 5, line 46) disclose that the acid generators in Aoi et al. are heat and light sensitive. The instant claims do not materially distinguish over the compositions of Aoi et al. coated on supports even though the intended use for making printing plates is not disclosed as explained in the final rejection. Applicants' argument that Aoi et al. and Fujimaki et al. are not combinable is unconvincing since the secondary prior art is cited to show inherent properties of acid generator compounds used in Aoi et al.

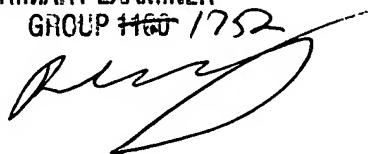
3. Claims 3 and 23-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The elements in Aoi et al are

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not used on Al supports for printing plates but rather on Si, ITO or glass supports for making circuits. The secondary prior art has different polymer binders from Aoaki et al. so that using the particular compositions of Aoaki et al. on lithographic plate Al supports is not suggested in the applied prior art. The applied prior art is silent as to the ink receptive properties of the resists formed in Aoaki et al.

Any inquiry concerning this communication should be directed to Richard L. Schilling at telephone number 571-272-1335.

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP ~~160~~ 1752

A handwritten signature in black ink, appearing to be 'R. Schilling', written over the printed name and group number.